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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,316	01/18/2002	Alfred Thomas	2100/17	8018

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EXAMINER

WHITE, CARMEN D

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 03/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,316

Applicant(s)

THOMAS ET AL.

Examiner

Carmen D. White

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-111 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-111 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7-9, 22, 24, 26-28, 36, 40-42, 47, 50-52, 64, 78-80, 83-85 are rejected under 35 U.S.C. 102(b) as being anticipated by *Marnell II* (5,393,057).

Regarding claims 1, 7-9, 22, 24, 26-28, 36, 40-42, 47, 50-52, 64, 78-80, 83-85, 96-103, Marnell teaches a method/gaming system of operating a gaming machine that comprises the steps of providing a first game of chance; providing a second game of chance which has the potential for achieving a prize award; operating said first game of chance; operating said second game of chance in conjunction with said first game of chance; and awarding any prize achieved in the second game of chance (abstract; Figures 1 and 2; col. 2, lines 45-55; col. 4, lines 5-55; col. 6, lines 14-24; col. 6, lines 56-65; col. 8, lines 49-65;

Claims 104 and 110 are rejected under 35 U.S.C. 102(b) as being anticipated by Acres et al (5,836,817).

Regarding claims 104 and 110, Acres teaches all the limitations of the claims relating to a gaming system with player tracking (abstract; Fig. 1 and Fig. 7A)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6, 10-20, 23, 25, 29-35, 37-39, 48-49, 53-62, 65-77, 81-82 and 86-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell II.

Regarding claim 25, Marnell teaches all the limitations of the claims as discussed above, Marnell lacks teaching a physical deck. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Marnell to make the game adaptable to live card games to make it more realistic and exciting.

Regarding claims 2-5, 15-19, 31-32, 34-35, 37-39, 48, 58-61, 65-71, 73-76, 81, Marnell teaches all the limitations of the claims as discussed above. While Marnell teaches a payout award, Marnell lacks teaching the various types of prizes disclosed in the instant claims. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include these types of prizes to give the players an added incentive to play the games. The examiner takes official notice that it is well known to offer various types of prizes, which includes toys, prepaid calling cards, etc.

Regarding claims 6, 29-30, 49, 82, 91-94, Marnell teaches all the limitations of the claims as discussed above. Marnell lacks the explicit teaching of operating the second game of choice once and at the beginning of the first game. However, the examiner asserts that it is well known in the art to have various conditions for initiating a second, bonus, game. Marnell is functionally capable of achieving this function- it is merely a matter of choice obvious to one of ordinary skill in the art. It would have been

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obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Marnell to attract the player's attention early in the game. This would increase the retention of players.

Regarding claims 10-14, 23, 53-57, 86-90, Marnell teaches all the limitations of the claims as discussed above. Marnell lacks the explicit teaching of the prize indicia for the second game being in a like number with the cards or the reels. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Marnell to increase the player's chances of predicting the outcome of the second game. Marnell is functionally capable of performing this function.

Regarding claims 20, 33, 62, 72, 77, 95, Marnell teaches all the limitations of the claims as discussed above. Marnell lacks the explicit teaching of a third bonus game. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Marnell to increase the players' chances of obtaining an increased award payout.

Claims 21, 43 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell II in view of Acres et al (5,836,817).

Regarding claims 21, 43, 63, Marnell teaches all the limitations of the claims as discussed above. Marnell lacks the explicit teaching of a player tracking system. Acres teaches this feature (abstract). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature of Acres in Marnell in order to give additional bonus game opportunities to players enrolled in the player tracking

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system. This would indicate to the casino/gaming establishment the players who spend the most money in gaming; thereby these players could be awarded for their patronage.

Claims 105-109 and 111 rejected under 35 U.S.C. 103(a) as being unpatentable over Acres et al.

Regarding the claims, Acres teaches all the limitations of the claims as discussed above. Acres is silent regarding the various types of prizes. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Acres for the reason listed above in the Marnell claim rejections.

Claims 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell II in view of Yamamoto (5,135,224).

Regarding claims 44-46, Marnell teaches all the limitations of the claims as discussed above. Marnell lacks teaching printing a slip. In an analogous gaming system, Yamamoto teaches this feature (abstract). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the slip of Yamamoto in Marnell to make it easier for players to obtain their prizes at a prize exchange station.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-308-7768 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.


C. White
Patent Examiner